

REMARKS

The Examiner's Final Action rejects all claims based upon Chisti et al. (5,975,893) as a primary reference, in view of Lehmann et al. (6,575,751). Chisti '893 is relied upon for disclosure of, inter alia, the delivery and receipt of feedback information relating to repositioning of teeth to a suggested post-treatment position. For this citation the Examiner identifies cols. 4-7 and 9-14 of Chisti '893.

Applicant has reviewed Chisti '893 in detail and has not identified any reference therein to, as the Examiner states it "receiving feedback information from a person (treating professional), other than the operator, and providing a custom orthodontic appliance configured to reposition teeth based on the suggested post-treatment tooth positions and orientations."

The Examiner's remarks state "[i]t is noted that the interactive step is written in the past tense, and interactivity can be interpreted as with the computer system. Furthermore, there is suggestion as to various times when "users" can provide feedback as in information to modify (change) or accept (not change) tooth positions and orientations in obtaining post-treatment tooth positions and orientations."

The Examiner is correct that the present claim language references "a person, other than the operator, who has interactively viewed a display of the provided images on the computer screen" which is in past tense. However, the method step recited is the receipt of feedback from such a person, which would follow the viewing of a display. This said, Applicant would emphasize in this phrase, not the verb tense as such, but the requirement therein that the person is other than the operator, i.e., the person that the feedback is from, is not the operator involved with the "interaction" in the immediately preceding claim step. Thus, two persons are

involved in interactive actions defining post-treatment positions based on data of images of teeth of a patient. Applicant has not been able to find this disclosed in the Chisti '893 patent.

Applicant also notes the Examiner's remark that "there is suggestion as to various times when 'users' can provide feedback as in information to modify (change) or accept (not change) tooth positions and orientations in obtaining post-treatment tooth positions and orientations". Presuming only for argument that Chisti '893 does sufficiently disclose an operator interactively developing a final tooth position, this is not sufficient to anticipate or suggest the claims. What Chisti says on this score, at col. 10, line 35 et seq., is that "the user will often follow a prescription or other written specification provided by the treating professional. Alternatively, the user may reposition them based on the visual appearance or using rules and algorithms programmed into the computer. Once the user is satisfied with the final arrangement, the final tooth arrangement is incorporated into a final digital data set."

Thus, in this quoted paragraph from Chisti '893, one user follows a prescription or a defined algorithm to create a final arrangement – which is not said to be subject to re-evaluation or feedback by others (including, for example, the "treating professional"), before a "final digital data set" is created. This is not a process in which an operator generates "suggested post-treatment tooth positions" and "a person, other than the operator, who has interactively viewed a display of the provided images" generates "feedback information" so that a customized orthodontic appliance is created "based on the suggested tooth positions and orientations in accordance with the feedback information", as is presently claimed.

The foregoing disposes of the rejection now in place. Applicant notes, however, the Examiner has relied upon the Lehman et al. US Patent 6,575,751 to form a rejection for obviousness. Lehman et al. was published on June 10, 2003, after the December 29, 1999 filing date claimed by the present application. Lehman et al. is only citable as prior art under 35 USC

102(e), for the reason that the present application claims a filing date of December 29, 1999 whereas Lehman et al. claims a filing date of November 3, 1998. However, Lehman et al. may be avoided as a reference to the present invention by the present inventors establishing prior conception and reduction to practice of the claimed invention, prior to Lehman's filing date of November 3, 1998.

Applicant is submitting herewith, declarations of the three inventors named herein, specifically, Eric Chapoulaud, Mark A. Payne and Dr. Craig Andreiko. Mr. Chapoulaud's declaration describes, and Dr. Andreiko and Mr. Payne confirm, a reduction to practice made by Mr. Chapoulaud and Dr. Andreiko at least by February 13, 1998. This is particularly elaborated in paragraphs 55-58 and the table that follows in Mr. Chapoulaud's declaration, and the corresponding paragraphs in the declarations of Mr. Payne and Dr. Andreiko.

Applicant submits that in view of the declarations submitted herewith, the Examiner's rejection based on Lehman must be withdrawn.

As a further remark, Applicant wishes to remind the Examiner of application Serial No. 09/169,034, also in the name of Chisti et al., which is CIP of the '893 patent, and is now issued as US Patent 6,471,511. The '511 patent is based on an application filed October 8, 1998 which includes disclosure not found in Chisti '893. The Examiner's attention is directed to Fig. 1 of the '511 patent for comparison with the figures of the '893 patent. As will be recognized, however, October 8, 1998 is after the February 13, 1998 date identified in the declarations filed herewith. Thus, further discussion of Chisti '511 is not required.

CONCLUSION

It is believed that no fee is due for this filing. If any fee is deemed due, consider this as an authorization to charge Deposit Account 23-3000 therefore.

Respectfully submitted,
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